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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/408,265	09/29/1999	ETSUKO KIMURA	Q55939	3838

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EXAMINER	
SING, SIMON P	
ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/408,265	KIMURA, ETSUKO	
	Examiner	Art Unit	
	Simon Sing	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 39 is objected to because of the following informalities: the "of" in the phrase in lines 5 and 6: "at the first predetermined position ***of*** at the second predetermined position" is a typo and should be changed to "or" so that the phrase reads: "at the first predetermined position ***or*** at the second predetermined position".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 21, 27, 33 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindholm 5,742,295.

2.1 Regarding claims 21 27 and 33, Lindholm discloses a computer (portable electronic device) in figure 3 with displays windows in figures 5 and 9, comprising:

a memory (a computer inherently comprising a memory) stores at least two functions, such as the Patch Configuration function in widow 84 (figure 5) and the Control Surface function window 88 (figure 9) and at least two items (Move and Deform) assigned to the Control Surface function;

a display which displays at least a first picture (screen display of figure 9) and a second picture (screen display of figure 5);

wherein the first picture comprises:

a) a function (Control Surface);

b) a first item (Move) displayed at a first predetermined position of the display and assigned to the displayed function; and

c) a second item (Deform) displayed at a second predetermined position of the display and assigned to the displayed function, and

wherein the second picture (figure 5) does not include any items which is displayed at either the first predetermined position or the second predetermined position;

a first button (function key F1) corresponding to the displayed first item (Move), wherein the pressing of the first button indicates the selection of the first item when the display is displaying the fist picture (column 15, lines 55-67);

a second button (function key F3) corresponding to the displayed second item (Deform), wherein the pressing of the second button indicates the selection of the second item when the display is displaying the first picture (column 15, lines 55-67);

wherein, when the display is displaying the second picture, the pressing of the first button or the second button indicates one or more actions unrelated to the first item or the second item (figure 5, F1= Edit, F3= Patch).

2.2 Regarding claim 39, Lindholm discloses a computer (portable electronic device) in figure 3 with displays windows in figures 5 and 9, comprising:

means (display screen in figures 5 and 9) for displaying at least a first picture (screen display of figure 9) and a second picture (screen display of figure 5);

wherein the first picture comprises a first item (Move) displayed at a first predetermined position and a second item (Deform) displayed at a second predetermined position; and

wherein the second picture does not include any items at the first predetermined position or the second predetermined position (figure 5);

a first execution (selection) means (function key F1), wherein a selection of the first item is executed (selected) by the first execution means (column 15, lines 55-67);

a second execution (selection) means (function key F3), wherein a selection of the second item is executed (selected) by the second execution means (column 15, lines 55-67);

wherein, a first action (F1 = Edit), which is unrelated to the first item or to the second item is executed by the first execution means when the second picture is being displayed, and a second action (F3 = Patch), which is unrelated

to the first item or to the second item is executed by the second execution means when the second picture is being displayed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 22, 28, 34 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindholm 5,742,295 in view of Shirley, Jr. et al. US 4,926,497 and further in view of Fernando et al. 6,193,152.

Lindholm teaches a computer with different functions displayed on a screen, but fail to teach displaying a key-tone function.

However, Shirley discloses a computer with another software which also assigns soft-key functions to the function keys F1-F10 for a particular function displayed (figures 1-12).

In addition, Fernando discloses a computing device which is able to turn a key-sound function so that when a key is pressed, an audible beep is generated (column 11, lines 36-44);

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lindholm's reference with the

teachings of Shirley and Fernando, so that a key-tone (sound) functions would have been included, because a key-tone function was well known in the art, and besides, a computer was able to display various functions based on different software such that the patentability of the computer could not be determined solely based on a particular software (e.g. key-tone function).

4. Claims 24, 30, 36 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindholm 5,742,295 in view of in view of Shirley, Jr. et al. US 4,926,497 and further in view of Busch et al. US 5,987,613.

Lindholm teaches a computer with different functions displayed on a screen, but fail to teach displaying an automatic power function.

However, Shirley discloses a computer with another software which also assigns soft-key functions to the function keys F1-F10 for a particular function displayed (figures 1-12).

In addition, Busch discloses a computer with automatic power down function to put the computer in a standby mode or sleep mode (column 3, lines 2-9, 15-24);

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lindholm's reference with the teachings of Shirley and Busch, so that an automatic power functions would have been included, because automatic power function was well known in the art, and besides, a computer was able to display various functions based on different

software such that the patentability of the computer could not be determined solely based on a particular software (e.g. automatic power function).

5. Claims 24, 30, 36 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindholm 5,742,295 in view of in view of Bradshaw US 4,730,252.

Lindholm teaches a computer with different functions displayed on a screen, but fail to teach that when the second picture is displayed, pressing the first button or the second button moves a cursor on the display to a first or a second direction.

However, Bradshoa discloses a computer display in figure 1. Bradshaw teaches that function keys, such as F9 and F10 move a cursor to different directions (column 2, lines 36-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lindholm's reference with the teaching of Bradshaw, so that function keys would have been assigned a cursor function and not displayed in the first and second predetermined positions, because a cursor function was well known in the art, and besides, a computer was able to display various functions based on different software such that the patentability of the computer could not be determined solely based on a particular software (e.g. cursor function).

6. Claims 25, 31, 37 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindholm 5,742,295 in view of Busch et al. US 5,987,613.

Lindholm teaches a computer with different functions displayed on a screen, but fail to teach that when the first button and the second button are located below the first item and the second item.

However, Busch discloses a portable computer in figure 8A (column 1, lines 57-67, column 2, lines 1-3). Bradshaw teaches that function keys (e.g. F1 and F3) are located below the display screen where first and second predetermined positions located (figure 8A).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lindholm's reference with the teaching of Busch, so that the computer would have been a portable computer and the function keys would have been located below the first and the second items, because portable computer was in the market for a long time and using either a desktop or a laptop computer would have been a matter of user preference.

7. Claims 26, 32, 38 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindholm 5,742,295 in view of Welch US 5,938,772.

Lindholm teaches a computer with different functions displayed on a screen, but fail to teach the computer is a phone.

However, Welch teaches a computer in figure 1. Welch teaches that when telephony software is installed, the computer is a telephone (column5, lines 42-43; column 8, lines 27-29).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lindholm's reference with the teaching of Welch, so that the computer would have been equipped with telephony software, and used as a phone, because computer telephony was well known in the art, and such modification would have further utilized the resource of a computer.

Response to Arguments

8. Applicant's arguments with respect to claim 21-44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (571) 272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

S. Sing

11/17/2005